

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

In re: :  
SPECTRUM DYNAMICS MEDICAL LIMITED, : Docket #1:18-cv-11386-  
 : VSB-KHP  
 :  
 Plaintiff, :  
 :  
 - against - :  
 :  
 GENERAL ELECTRIC COMPANY, et al., : New York, New York  
 : December 18, 2020  
 Defendants. :  
 : TELEPHONE CONFERENCE  
 ----- :

PROCEEDINGS BEFORE  
THE HONORABLE JUDGE KATHARINE H. PARKER ,  
UNITED STATES MAGISTRATE JUDGE

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Proceedings conducted telephonically and recorded by  
electronic sound recording;  
Transcript produced by transcription service

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E X A M I N A T I O N S

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None

E X H I B I T S

<u>Exhibit Number</u>	<u>Description</u>	<u>ID</u>	<u>In</u>	<u>Voir Dire</u>
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None

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2 THE CLERK: Calling case 18 civil 11386, Spectrum  
3 Dynamics Medical vs. General Electric Company, the  
4 Honorable Katharine H. Parker, presiding.

5 Beginning with counsel for the plaintiffs, can you  
6 please make your appearance for the record?

7 MR. GREGORY MILLER: Good morning, Gregory Miller,  
8 Rivkin Radler LLP, on behalf of the plaintiff. Also with me  
9 on the call is Neil Greenblum and Branko Pejic from the  
10 Greenblum & Bernstein law firm. Good morning again.

11 HONORABLE KATHARINE H. PARKER (THE COURT): Good  
12 morning.

13 THE CLERK: And counsel for the defendants, could  
14 you please make your appearance for the record?

15 MS. MARLA BUTLER: Yes. This is Marla Butler. And  
16 with me are my colleagues, Jesse Jenike-Godshalk and Brian  
17 Lanciault, for defendants, from Thompson Hine.

18 THE COURT: Good morning.

19 MS. BUTLER: Good morning.

20 THE COURT: Okay, so we are here today to talk about  
21 two motions, the motion by Spectrum to (indiscernible) more  
22 detailed infringement contentions, and the motion to serve  
23 contention interrogatories. So what I'd like to first do is  
24 talk about the detailed infringement contentions. I want to  
25 understand a little bit more what Spectrum is saying. And

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this ties a little bit into the trade-secret issue that --  
a claim, I believe, that Spectrum has asserted.

So, Mr. Miller, are you going to be speaking for  
your client?

MR. MILLER: Actually, it will be Mr. Branko Pejic  
who will be making our argument today.

MR. BRANKO PEJIC: Good morning, your Honor.

THE COURT: Okay. So before we get started, let me  
just remind everybody that this call is open to the press  
and public on a listen-only basis. We are making a  
recording. If you'd like a transcript, you have to order it  
within three days. The Court otherwise prohibits the  
recording and rebroadcasting of court conferences. And I'd  
ask all the parties to keep their phones on mute unless  
they're speaking. And for the benefit of any court  
reporter who may transcribe the transcript, please state  
your full name before you speak.

All right, so I'll first hear from Spectrum.

MR. PEJIC: Good morning, your Honor. This is  
Branko Pejic. And I will first speak to the motion seeking  
more detailed infringement contentions from defendants.  
Basically, what Spectrum's trying to do here is streamline  
the case such that we don't end up in a situation where  
we're having to take seventy depositions and all the other

things that are associated if contention interrogatories are not served.

But specifically, with respect to the infringement contentions, this is an interesting situation where Spectrum claims that these patents are the result of misappropriated trade secrets. And to the extent that defendants seek to stretch the claim scope to cover the accused device, those claims are invalid as obvious.

One of the things that complicates the fact of the detailed contention inter -- not contention interrogatories -- I'm sorry -- the infringement contentions under the local patent rules is the plaintiffs have just identified a device and certain claims that are infringed without explaining where the feature on the device is, as well as whether the claim is being construed under Section 112 as means plus function. Further, the defendants do not state whether the infringement is direct or literal or even under the doctrine of equivalence.

And --

THE COURT: Well, Mr. Pejic, I'm looking right now at what defendant has provided to you. So there's two devices, as I understand it, although they work very similarly, and there's two patents at issue, as I understand it.

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MR. PEJIC: Yes, your Honor.

THE COURT: Okay. And as I understand it, Spectrum is saying and brought this action saying that defendants stole certain trade secrets, and you identified those trade secrets in your Complaint, and Judge Broderick dismissed the claims as to certain trade secrets but other identified trade secrets are still in play. And you brought the claim saying that these were your trade secrets, that defendants stole them and they used them for these two devices, right, the imitation device, as you call it, and that they're imitating the VERITON and the VERITON-CT?

MR. PEJIC: That is correct, your Honor.

THE COURT: Okay. So you've identified and the Court has accepted certain of those trade secrets. And you're saying that they were utilized in these allegedly copycat machines. Now, the counterclaim is saying no, these machines are based on our own technology, and you're saying no, it's not and trying to invalidate their patent.

So we're talking about these machines. And when I'm looking at what defendant has provided, I see for Patent 439 it has -- defendant has specifically identified the particular claim from that patent and then it has provided pictures of your machine with an explanation of how GE believes that it infringes on its patent. Now,

presumably you know the trade secrets. I mean, I'm thinking you can just take this chart and you can just put the trade secrets right next to these claims that this is -- I'm assuming that the trade secrets have to do precisely with the same claims. Maybe I'm wrong about that, but I don't understand what exactly is deficient at this stage of the litigation with this pretty detailed chart that GE has provided and including outlining specific pieces of the VERITON, you know, encircling it and talking about how it relates to the claim.

MR. PEJIC: Your Honor, this is Branko --

THE COURT: So if --

MR. PEJIC: Oh, I'm sorry. Did I cut you off, your Honor?

THE COURT: No. Go ahead.

I need a better explanation as to what is missing.

MR. PEJIC: Okay. You are absolutely correct; and in fact, in Spectrum's invalidity contentions that were served earlier this week, we did exactly that.

THE COURT: Okay.

MR. PEJIC: But what is missing in, for example, you talked about the detailed claim charts for Claim 1 of the 439 patent, but the remaining claims defendants just say, "See above," including for independent claims of



different scope. So, at a minimum, Spectrum believes that the defendants should provide a detailed claim chart for all the claims, not just independent Claims 1 of the 595 patent and the 439 patent. The claim charts were provided for just those two claims, not all the claims asserted.

THE COURT: Okay. But, as I understand -- like, for example, I'm looking at Claim 2 for the first patent in issue, patent in suit, which those are -- they're just referencing the apparatus in Claim 1, and then they're going into this description for this claim with the weight compensation unit with the counterbalance, and then they're describing -- so I think two is related to one but is modifying it a little bit. So I'm not -- can you explain a little bit more --

MR. PEJIC: Yes, your Honor. You're absolutely right. And in doing Claim 1 and 2 in that manner is appropriate because Claim 2 is a dependent claim from Claim 1.

THE COURT: Right.

MR. PEJIC: So it is appropriate to reference Claim 1. But if you'll turn the page, then, to look at Claim 9, which is itself an independent claim having different scope and different limitations, all that is provided is a "See above." And what Spectrum believes is

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2 it's appropriate to provide the same limitation-by-  
3 limitation analysis for the independent claims because they  
4 are of a different scope and contain different limitations.

5 THE COURT: Okay. Okay, so what's really --

6 MR. NEIL GREENBLUM: Your Honor --

7 THE COURT: -- what you're saying is you need more  
8 detail on the (indiscernible).

9 Okay, so --

10 MR. GREENBLUM: Your Honor, this is Neil  
11 Greenblum. I don't want to interfere with the dialogue that  
12 you've been having, but since this is an early stage of the  
13 case and your Honor has obviously studied the matter  
14 carefully, there is a track that you're going down that I  
15 just wanted to alert you to so that we don't get off on the  
16 wrong foot. The trade secrets that were disclosed we claim  
17 are in the device, but they were also in many documents.  
18 So it was not only in the device that these trade secrets  
19 appear, some of them. And the patent issues, as at least we  
20 see it, are separate from the trade secret issues even  
21 though they involve the same patents and whatever. And so I  
22 just wanted to -- I think your Honor is sort of assuming  
23 that because we said their device incorporates our trade  
24 secrets, that as a result of that, we already know what's  
25 in their device, and we already know that it's in the

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2 patent.

3 THE COURT: Right.

4 MR. GREENBLUM: And what I think your Honor is  
5 missing here is that when it comes to trade secrets, that's  
6 one form analysis. When it comes to patent infringement,  
7 which is what's being alleged here, there's a different  
8 analysis that takes place. And with the patent  
9 infringement part of the case, the claims -- you look at  
10 the words. In other words, they may have disclosed our idea  
11 totally in their patent, but when it comes to the question  
12 of infringement, it's not the disclosure that counts only;  
13 it's what they specifically claim.

14 THE COURT: Right.

15 MR. GREENBLUM: And so we will be arguing that we  
16 don't do what's in those claims; and in order to do that,  
17 we need the specificity that we feel it's lacking in order  
18 to be able to respond and to get this case going on the  
19 right track. So I apologize for interrupting, but I just  
20 wanted to point that out.

21 THE COURT: Okay. Thank you. I understand the  
22 distinction that you're making. So -- but just so that I'm  
23 clear, are you saying, Mr. Greenblum, that there are some  
24 trade secrets that are not incorporated into the machine  
25 and that are just separate trade secrets that were

disclosed?

MR. GREENBLUM: You know, nothing having to do with just the issue we're discussing today, but, sure, there are many trade secrets that we -- we listed, I think, 16 of them or whatever, 18, 17 --

THE COURT: Right.

MR. GREENBLUM: -- that are disclosed impermissibly in documents and patents. And we claim that they impermissibly disclosed these. So what you're seeing here, it just so happens that these two patents we claim also disclosed our trade secrets. However, the -- and these two patents -- I'll give you this piece of information so that we don't get off on the wrong track -- these two patents were filed shortly after -- shortly after -- they were disclosed in a document of ours. And the Courts abjured distinction and said, well, these two patents, they already were filed after you disclosed it, so I'll only let you claim trade secret protection if you can establish for these two that the defendant used the trade secrets before you filed. This is a bit of minutia, but I want to give your Honor a sense that the patents and trade secrets, if you conflate them, should conflate them, it gets confusing.

I think in this -- and I would respectfully submit that in this part of the case, what we're talking about

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2 today, the question is okay, you have a patent, it has  
3 patent claims, did the defendant specify the elements of  
4 each of the claims that are infringed.

5 THE COURT: Okay.

6 MR. GREENBLUM: And we submit they didn't. And  
7 what concerns us -- what concerns us -- is that the three  
8 drawings or photographs that were submitted are from three  
9 different machines, your Honor. They didn't explain that.  
10 They were called VERITON. VERITON is a generic name for us.  
11 And they are from three different machines. So we need more  
12 specificity.

13 THE COURT: Okay. So are you saying that the --  
14 are there more than -- so what's the other machine? There's  
15 the VERITON --

16 MR. GREENBLUM: No, I will --

17 THE COURT: Well, what about the different names  
18 of the different machines?

19 MR. GREENBLUM: I will explain, your Honor. The  
20 photographs that they provided are from videos. Those  
21 videos were mockup demonstrations. You don't infringe a  
22 patent with a mockup video or a video of a mockup. You only  
23 infringe a patent with an actual machine or a method of  
24 using an actual machine. And what they did was they took  
25 segments of different videos or photographs or

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2 publications, threw them all on the page and said, you have  
3 each of these three. But to infringe a patent -- to  
4 infringe a patent -- you have to infringe in one claim all  
5 of the elements of the claim in a single device.

6 THE COURT: Sure.

7 MS. BUTLER: Your Honor, might I respond for  
8 defendants?

9 THE COURT: So -- yes, Ms. Butler, go ahead.

10 MS. BUTLER: Okay. As to the issue of what  
11 machines were identified, you know, I will note that these  
12 are infringement contentions at the beginning of the case  
13 based on publicly-available information. And basically,  
14 Mr. Greenblum's argument is that GE did not identify what  
15 only Spectrum knows. Right? So Spectrum apparently knows  
16 that these are three different machines and that these are  
17 mockups. There's no indication of that in the public  
18 record. GE has satisfied its requirement to identify the  
19 device that is publicly named VERITON and the VERITON-CT;  
20 GE has identified those devices and has met its obligation  
21 under Patent Rule 6. Certainly, we will have more than a  
22 year of discovery in this case and will have the  
23 opportunity to uncover the various machines that  
24 Mr. Greenblum alludes to. But we have done what the rule  
25 requires us to do.

And I'll also point out that, you know, patent issues, I agree with Mr. Greenblum on this point that the patent issues are separate. And whether or not GE has met the requirements of Patent Rule 6 is completely separate from the trade-secret allegations that are asserted in this case, because, to the extent those trade-secret allegations fail, GE's patent claims remain.

The last thing I'll point out is that as to claims, I think it was nine of the example we were discussing, Claim 9 of the first patent that's at Tab A, Exhibit A, the elements of those claims are all found in the claims that were charted above. Oftentimes when patent claims are written, you will have ten different claims, and maybe there are only five elements among those claims, but they will be organized differently. And so if you look at Claim 9, which claims a gantry, for example, in the earlier claim GE identified what the gantry was. And if you look to all of the elements of Claim 9, GE in the earlier claims identified where all of those elements are located in the Spectrum device.

So I will leave it at that at this point, your Honor.

THE COURT: Ms. Butler, are you saying that for Claim 17, as well, that the same applies?

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2 MS. BUTLER: Yes.

3 THE COURT: Because here 17 appears to be related  
4 to nine insofar as it's dealing with a camera system and  
5 describing the gantry, the movable column, the  
6 counterweight.

7 MS. BUTLER: So, yes, your Honor, all of the  
8 elements of Claim 17 are also found in Claims 1 and 2.  
9 Claim 17 is an independent claim, so it does not depend  
10 from Claim 9. It's an independent claim; but if you look at  
11 Claim 17, as an example, look at the last sentence of what  
12 GE has in the right-hand column. It says, "Thus, when  
13 Spectrum makes the accused product, it performs each step  
14 of the claimed method of forming a camera system." And then  
15 before it got to that sentence, it pointed to those  
16 different elements in Claims 1 and 2 above.

17 You know, I'll also note that Spectrum on this  
18 call has now narrowed its motion significantly. It brought  
19 this motion claiming that GE did not identify whether the  
20 claims were directly or indirectly infringed, even though  
21 on the very first page of GE's contentions, GE says  
22 Spectrum directly infringed and is continued to directly  
23 infringe, and identified all of the claims. And GE also  
24 said Spectrum has contributed to and/or induced direct  
25 infringement by others of those same claims. So, I mean,



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2 it's almost like the motion was written without having  
3 reviewed the contentions that are in front of it. I think  
4 the only issues that really are in dispute is whether those  
5 Claims 9 and 12, whether GE properly referred to Claims 1  
6 and 2. And for the reasons I just described, I think we  
7 did properly refer to those claims.

8 And the only other issue that appears to be in  
9 dispute is whether GE was required at this stage to  
10 indicate whether the claims were to be construed under  
11 Section 112-6 of the patent statute. In other words,  
12 they're arguing that GE should have provided its claim  
13 construction position in its infringement contentions, even  
14 though, number one, nothing in the rule even remotely  
15 requires that; and, number two, there's a whole section of  
16 the Scheduling Order that's devoted to claim construction.

17 THE COURT: Right. And you --

18 MS. BUTLER: Both of these issues --

19 THE COURT: -- you're going to have the Markman  
20 hearing in June.

21 MS. BUTLER: That's right. And so neither of  
22 these issues has merit, your Honor, and we'd request that  
23 this motion be denied.

24 MR. PEJIC: Your Honor, this is --

25 THE COURT: Can I ask you one question --

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2 MR. PEJIC: -- may I please respond?

3 THE COURT: In a moment. I have another question  
4 for Ms. Butler.

5 Ms. Butler, how much do these machines cost? I'm  
6 afraid to ask.

7 MS. BUTLER: And, your Honor, we don't -- I don't  
8 know how much the VERITON, the accused VERITON and VERITON-  
9 CT systems cost. They're new to the market, and I don't --  
10 my client might have that information; your Honor, I don't.  
11 Perhaps Spectrum's counsel would.

12 THE COURT: Okay. And how much do GE's  
13 machines -- and what are you calling your machines?

14 MS. BUTLER: [REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]

19 THE COURT: Okay. And --

20 MS. BUTLER: But they are -- to the extent the  
21 point is are they very expensive machines, and the answer  
22 to that would be yes.

23 THE COURT: Yes, right. That's my assumption,  
24 million-dollar machines or something. Okay.

25 So is that Mr. Greenblum, you wanted to respond?

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19

MR. GREENBLUM: Well, that was Mr. Pejic, but I was just saying I would like to direct the Court to -- I think the issue is becoming clearer. The claims are not all of the claims of the same scope. Your Honor realizes the reason that we have different claims is because they are all a different scope. If any of them are of the same scope, they're invalid as being repetitive.

THE COURT: Right.

MR. GREENBLUM: So Claim 1 was used as the model. Claim 1 uses the phrase "a column attached to a gantry."

THE COURT: Yes.

MR. GREENBLUM: Okay. Claim 9, which Ms. Butler just referred to, calls for a column extending from the gantry. That will prove to be an issue in the case. And what Spectrum feels it's entitled to is to have a clear statement as to each claim so that we go off on the track for purposes of Markman or whatever where we know that they are saying, yes, we abstain from it, and also we're attached from it -- attached to it. So that's a good example of the need for a little more specificity in the submission that GE made. It's not there, so we're led to assume that they consider "extend from" and "attached to" as being the same thing. That's the way they've got it now. But it shouldn't be that way. They should have to

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2 address each element of a claim.

3 MS. BUTLER: Can I respond to that point, your  
4 Honor?

5 THE COURT: Hold on. I want to ask Mr. Pejic a  
6 question.

7 MS. BUTLER: Yes.

8 THE COURT: So I'm -- looked at this extend  
9 from -- you know, I'm not a patent expert, and I'm  
10 certainly not an expert on any of these technical issues.  
11 So what more do you -- I guess I don't quite understand  
12 what more you need at this point in the litigation. You  
13 know, here you've got the camera system comprising of the  
14 gantry. So you understand what the gantry is. The column  
15 extending -- okay, so it's extending and has a movable  
16 radiation detector and a counterbalance weight to apply  
17 force. So I guess, you know, you said in your letter you  
18 need to understand more limitations. What more at this  
19 point do you not understand?

20 MR. PEJIC: WE would want them to say -- to point  
21 to when they did their infringement contentions, that they  
22 say here's the elements, with an arrow -- I'm using that  
23 figuratively, "with an arrow" -- and this is where it  
24 extends. That's it; that's all we're asking.

25 THE COURT: But where it extends?

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2 MR. PEJIC: In other words, point to the extension  
3 that you're talking -- you say it extends, so just point to  
4 it. "See, here is where it extends," not to leave it to us  
5 to look at the picture and figure out how they are  
6 construing it. For them to say, "Here is the element. You  
7 see it extends, and here is where it extends." That's it.

8 THE COURT: Okay. So -- but I look at the picture  
9 above, Mr. Pejic, in two, there's an arrow pointing to the  
10 movable section, which I take it to mean the piece that's  
11 extending.

12 MR. PEJIC: Well, we --

13 THE COURT: Is that not correct?

14 MR. PEJIC: Well, that --

15 THE COURT: And also above show the counterweight,  
16 which looks to be -- it's a little unclear where that is.  
17 Let me ask you something, Mr. Pejic. Is your machine, the  
18 VERITON, now is that a machine that's being sold in the  
19 market, and how much is it?

20 MR. PEJIC: Okay. So the mockups that were -- or  
21 the figures that you have in front of you are from  
22 magazines that depict what was shown, some of them, in  
23 Europe.

24 THE COURT: Okay.

25 MR. PEJIC: Infringement has to be in the United

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2 States, not in Europe.

3 THE COURT: Okay.

4 MR. PEJIC: So we are entitled to have the  
5 plaintiff specify -- I'm sorry -- the defendants specify  
6 that this mockup was a real device or it isn't. We're  
7 entitled to have them say this is the device that's sold in  
8 the United States. They've said that, but they then  
9 provide a video or a picture from something that is sold in  
10 Europe.

11 THE COURT: Okay, but can you answer my question?

12 MR. PEJIC: Oh, sure.

13 THE COURT: Are you selling this device --

14 MR. PEJIC: Yes. Yes, it is --

15 THE COURT: -- the VERITON, inside the states?

16 MR. PEJIC: There is a VERITON device, of course,  
17 that is sold in the United States. It costs, my  
18 understanding, it's about a million dollars.

19 THE COURT: And is it the VERITON and the VERITON-  
20 CT? What are sold in the United States?

21 MR. PEJIC: There is a VERITON machine, and it has  
22 attached to it what's called a "CT," a tent scan. The two  
23 of them are sold together. So --

24 THE COURT: Okay.

25 MR. PEJIC: But the VERITON is the VERITON alone,

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2 and the VERITON is the VERITON that's sold together with  
3 the CT.

4 THE COURT: And are both versions being used in  
5 the United States right now? They have FDA approval and  
6 they're being --

7 MR. PEJIC: Oh, they're approved. I don't know  
8 which ones exactly have been sold.

9 THE COURT: Okay. But do you know that -- so  
10 they've been approved, and you know for a fact there are  
11 some here in the United States. Where are they?

12 MR. PEJIC: Yes, oh, yes, there are some here in  
13 the United States. They're at two hospitals -- I'm not  
14 sure which hospitals. But I will tell you -- I will tell  
15 you that the ones that are here do not what those mockups  
16 from Europe show.

17 THE COURT: Okay.

18 MR. PEJIC: They don't do it. They don't do it.

19 THE COURT: So do you know what hospitals they're  
20 at?

21 MR. PEJIC: Pardon me?

22 THE COURT: Sorry, you just told me that. You  
23 don't know where they are?

24 MR. PEJIC: Right. I don't know. I don't know  
25 these ones.

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2 THE COURT: I mean, I'm assuming they're in some  
3 major metropolitan area, Cedars Sinai in Los Angeles or,  
4 you know, some of -- one New York City hospital that can  
5 afford the machines.

6 MR. PEJIC: Yes.

7 THE COURT: And these are for cardiac patients  
8 principally. So maybe one's at Weill Cornell in the city,  
9 who knows. Okay.

10 MR. PEJIC: Yes.

11 THE COURT: So, Ms. Butler, has your client gone  
12 to inspect any of the machines at the hospitals, the  
13 VERITON machines?

14 MS. BUTLER: Your Honor, as far as we understand,  
15 there was a couple of things. There is one machine that we  
16 believe was sold in Boston.

17 THE COURT: Okay.

18 MS. BUTLER: And that's the one that we're aware  
19 of. And there was -- a lot of this is kind of based on  
20 information that salespeople might have, for example. There  
21 was either a sale or an offer for sale to the Mayo Clinic  
22 in Rochester, Minnesota.

23 THE COURT: Okay.

24 MS. BUTLER: Getting in and seeing these machines  
25 is not practical because companies have agreements with



1 hospitals that would not -- and these are in -- they're in  
2 use -- right? It's not like we can go in and interrupt the  
3 use of this machine to do an infringement inspection, which  
4 is why we relied on the publicly-available information that  
5 was available to our client.  
6

7           What Spectrum seems to be doing here is choosing  
8 to pick a fight about whether or not the device infringes  
9 in the context of whether GE has met its requirements under  
10 Local Patent Rule 6. And I think in all of this  
11 discussion, your Honor, we have missed the point that the  
12 local patent rules actually don't require GE to provide any  
13 claim charts. Right? I mean, they are clear in requiring  
14 two things and two things only, that GE identify each claim  
15 of each patent in suit that is alleged to be infringed and  
16 that GE identify the product that infringes. That is clear  
17 by the express language of the patent rule, and it's clear  
18 by the, albeit very limited, case law on this issue. But  
19 that's all that GE has to provide.

20           Spectrum is arguing that even though GE provided  
21 claim charts, that those claim charts aren't good enough,  
22 when GE didn't have to provide those claim charts at all.  
23 I'll note that Mr. Greenblum or Mr. Pejic -- I don't recall  
24 at this point who it was -- mentioned Spectrum's invalidity  
25 contentions, your Honor, which are basically the mirror

1  
2 image of the infringement contentions.

3 THE COURT: Sure.

4 MS. BUTLER: And in those invalidity contentions  
5 they said -- this is a quote -- None of the Court's present  
6 orders nor Local Patent Rule 7 requires Spectrum to  
7 disclose claim charts providing a limitation-by-limitation  
8 invalidity analysis, comparing the limitations of the  
9 asserted claims to the prior art. So Spectrum is here today  
10 arguing that GE was not only required to provide claim  
11 charts, but it had to be claim charts that included  
12 information that wasn't publicly available. And they, on  
13 the other hand, are not required to provide claim charts  
14 under the analogous local rule for invalidity contentions.

15 This is a manufactured --

16 THE COURT: Okay. Well, I --

17 MS. BUTLER: -- dispute, your Honor.

18 THE COURT: Okay. So I understand the point about  
19 what's required now, but I'm just thinking practically,  
20 because the purpose of some of these disclosure rules is to  
21 try to focus discovery and limit discovery and avoid  
22 exchange of trade secrets and other information if there's  
23 not really a potential for a claim. So what I'm hearing  
24 Mr. Pejic say is that the pictures that you have, the  
25 publicly-available pictures that you believe show an

infringing product are not at all like the VERITON sold in the United States. That's kind of hard for me to believe, Mr. Pejic, because I can't believe it would vary so much from what you were showing in Europe. So I'm not quite understand -- I don't quite understand why there would be any kind of significant variation in the machines. Can you explain to me what is different?

MR. PEJIC: Well, yes, your Honor. This is Mr. Pejic. What was shown in Europe was a product that had not been approved and was undergoing development. And it was being shown in various shows. What is telling, though, as far as the difference between mockups and what is actually sold is defendants do cite the VERITON brochures in their infringement contentions but do not apply any of those brochures to the independent claims. So to the extent that there is public information that describes the actual VERITON that's being sold in the US, defendants don't avail themselves of that information in alleging infringement of the independent claims, nor do defendants use those brochures to back up the pictures that they are showing of the mockups.

THE COURT: But do the brochures have pictures like -- that could be used in a mockup?

MR. PEJIC: The brochures talk about the

functionality and operation of the machine; and to the extent it does not have a picture, defendants certainly could cite any provision from the brochure saying that it has -- that VERITON has this functionality and point to the picture. But they don't avail themselves of that.

THE COURT: So you're saying the brochures that are publicly available do describe the actual machine that's in the US?

MR. PEJIC: They relate to and describe. I don't know at what level of complete detail, but they are representative of the VERITONs sold and offered for sale and sold in the US.

MS. BUTLER: Can I respond to that, your Honor?

THE COURT: Yes.

MS. BUTLER: So to the extent -- we did look at the brochures. There is very little depth to those brochures. We went to publicly available information that provided the most detail. So there are some instances where there was relevant information from the brochure; and when the brochure did not provide detailed-enough information, we went to the videos.

But as a practical matter, your Honor mentioned that you're looking to kind of figure out what's practical here.

THE COURT: Right.

MS. BUTLER: I'd like to propose a solution in that regard. So we've mentioned that Spectrum has served invalidity contentions. And GE has now served infringement contentions, which we believe more than satisfy what the rules require. But to the extent Spectrum feels that it would be beneficial for us to flesh out, for example, Claims 9 and 17 of our chart for the 439 patent, GE would be willing to do that. But then we believe that Spectrum then should also provide claim charts for all of the prior art that it listed in its invalidity contentions. In other words, we should go one way or the other here. If Spectrum wants GE to flesh out Claims 9 and 17 so that Spectrum knows where the column is extending from the gantry -- right? -- GE will be willing to point that out. But then in its invalidity contentions instead of listing dozens of prior art references with no claim charts attached, Spectrum should be providing claim charts that compare those prior art references to the asserted claims, as well.

MR. PEJIC: Your Honor, may I respond?

THE COURT: Yes. And I want to know, when you respond, I also want you to tell me are there more patents at issue in Spectrum's affirmative claims.

MR. PEJIC: Okay. First, the first thing I'd like

1  
2 to state is I appreciate defendants' attempts to move the  
3 ball forward, but one of the problems with the proposal is  
4 what prior art is relevant will depend completely upon how  
5 the claims are construed by the Court, as your Honor is  
6 well aware. So what defendants are now trying to seek to  
7 require Spectrum to do is what they are also seeking to  
8 make Spectrum do with the contention interrogatory  
9 identifying trade secrets. But --

10 THE COURT: Wait a minute. Isn't that a little  
11 cute? Because you brought your affirmative claim seeking a  
12 declaration about inventorship. So, you know, it's not --

13 MR. PEJIC: Your Honor -- I'm sorry -- I'll try  
14 to -- let me unpack that. If a claim is construed one way,  
15 the VERITON would not infringe, and the prior art would not  
16 invalidate. If construed another way, that could implicate  
17 potential infringement as well as additional prior art.  
18 And so that is why in most situations you're certainly  
19 allowed to amend any of your contentions after claim  
20 construction.

21 MS. BUTLER: But, your Honor, they did not provide  
22 claim charts for the vast majority of the prior art  
23 references in their invalidity contentions. And the  
24 rules -- the rules --

25 MR. PEJIC: (Indiscernible)

1 PROCEEDINGS 31

2 MS. BUTLER: -- are that infringement contentions  
3 and invalidity contentions are both to be served at the  
4 beginning of this case. So if we're trying to be practical  
5 and provide as much information up front as possible, then  
6 GE can flesh out Claims 9 through 17 -- 9 and 17, and  
7 Spectrum should provide claim charts for its invalidity  
8 contentions.

9 Your Honor, I want to just point out I do have a  
10 conference with a federal court in Minnesota at 11 o'clock.  
11 I just wanted to inject that here for time purposes as  
12 we're diving more and more into these --

13 THE COURT: Yes.

14 MS. BUTLER: But I do think that that -- if we're  
15 trying to provide -- figure out a way to give information  
16 more up front, then let's do it, but let's do it both ways.

17 MR. PEJIC: Your Honor, may I --

18 THE COURT: Well, that's --

19 MR. PEJIC: -- may I please finish?

20 THE COURT: Well, hold on a second. I'm of the  
21 view that there should be more information provided by both  
22 sides up front so that you can get going and understand  
23 what, you know, what each other is saying. So plaintiff  
24 definitely has an idea, because you've identified the trade  
25 secrets that you think defendant has disclosed, and you

also have some ideas about the patent because you've asserted the inventorship, you know, claim; and now you have the invalidity claims.

So I think both sides need to provide some more detail. And I do think that the -- it's not just 9 and 17, because there's some ones in the second patent also --

MR. PEJIC: Right, your Honor.

THE COURT: -- that need to be -- that a little bit more detail would need to be provided. So, for example, 7 -- I mean, 7 does have a chart. But there may need to be a little bit more detail in 7, 8, 10, 11 and 18 of the second patent. And it does seem to me that you might be able to get a photograph or some photographs of the machine that's in use in Boston.

MS. BUTLER: Your Honor, if Spectrum --

THE COURT: I understand that you can't reverse-engineer it, you can't go in to do that. But, I mean, why can't you get a photograph of it?

MS. BUTLER: Because, your Honor, it's a private hospital that would -- I don't think would allow a bunch of lawyers to come in and stop their actual use of the machine to do that. But I will say that if Spectrum arranges for that, GE would be happy to do that. But I honestly don't believe that GE can just call up the hospital and say that,



"We've got this lawsuit against Spectrum. We need to stop using this machine to image patients so that we can come in and do an infringement analysis."

THE COURT: Yes. But the machine is probably not in constant use, particularly now when the hospitals are filled with COVID patients and not even seeing patients, you know, for -- I'm not exactly sure what the situation is in Boston, but because of the particular crisis we're in right now, you may actually have, you know, a time period where there can be a few pictures taken because people might not be coming in to use that machine right now, you know, because they're focused on the COVID patients. So since there's very few of these machines, it seems to me that that's something that could be done and should be done. And it also seems to me that plaintiff could provide some more details about their invalidity claims at this point so you can join issues, if you will on --

MR. PEJIC: Your Honor --

THE COURT: -- on your respective claims.

MR. PEJIC: -- your Honor, if I may? You're basing your suggestion that we provide additional information on our invalidity claims. I don't know that you've seen our invalidity analysis, but we'd be glad to submit it to you.

THE COURT: Okay.

MR. PEJIC: And if you look at -- I mean, you seem to be drawing an equivalence here between what the plaintiff did and what the defendant did, and that's based upon defendant counsel's assertion. But I think if you look at what we did, you will see that we were extremely detailed -- extremely detailed -- in our invalidity analysis based upon the key documents that we say teaches everything. In those few cases where --

THE COURT: Okay.

MR. PEJIC: -- there some question, we specify by page and line the prior art. We then went -- what opposing counsel was referring to was we said, so we think this knocks it all out, this knocks it all out; but we said to the extent that there is need for reference for the general state of the art -- the general state of the art -- we didn't apply them against the claims -- we said this is the general state of the art, and we listed these documents. We did not apply them because what we assert is invalid is specified in great detail -- you can see it, page and line numbers.

THE COURT: Okay.

MR. PEJIC: And so I would suggest that before -- I would ask that your Honor hold in abeyance a general request that we get more specific -- that you take a look

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2 at them --

3 THE COURT: Okay.

4 MR. PEJIC: -- and we would submit them to you.

5 THE COURT: All right, so --

6 MR. PEJIC: And as to --

7 THE COURT: -- why don't -- can you submit them by  
8 Monday?

9 MR. PEJIC: Sure, sure.

10 THE COURT: Okay. Why don't --

11 MR. PEJIC: And as to -- okay. And as to your  
12 Honor's suggestion about looking at the machine, I'd like  
13 to think about it and discuss it with my client, but this  
14 might be a way to eliminate this part of the lawsuit very  
15 quickly.

16 THE COURT: Right.

17 MR. PEJIC: And -- which is what I think your  
18 Honor is going to. If Greenblum is telling you that it's  
19 not sold like that here, then why are we here?

20 THE COURT: Right.

21 MR. PEJIC: And so I'd like to discuss it with my  
22 client and see if we can arrange for something like your  
23 Honor is proposing --

24 THE COURT: I mean --

25 MR. PEJIC: -- and we --

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2 THE COURT: -- (indiscernible) spend money on --  
3 if the machine is not as it's appearing, then, you know,  
4 let's provide that information. That's --

5 MR. PEJIC: That's right.

6 THE COURT: Okay. So why don't you talk to your  
7 client and send me the invalidity contentions that you did  
8 on Monday. I'll hold the ruling in abeyance. And talk with  
9 your client next week, and I want you to talk with  
10 defendants about getting some photographs and some, you  
11 know -- and then I want you to send me a status letter the  
12 following week, because I'm mindful that it's Christmas Eve  
13 and Christmas on Thursday and Friday of next week. So I  
14 don't -- you know, I don't know what the schedule will be  
15 with your clients and the hospital and whatever. So I'd  
16 like you to get me a status letter by the 31st. And I'd  
17 like you to work cooperatively about this because just some  
18 photographs may provide some -- you know, and I don't know  
19 what other -- you may be aware, plaintiff may be aware of  
20 more public information that will provide a little bit more  
21 understanding for the defendants. And maybe, you know,  
22 maybe that will really narrow the issues. So let's --

23 MS. BUTLER: Your Honor --

24 THE COURT: Yes.

25 MS. BUTLER: Your Honor, just in light of the

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2 time, I just wanted to inject one more request, and that is  
3 that when Spectrum submits to you its invalidity  
4 contentions on Monday, that the parties be permitted just  
5 two pages to discuss why Spectrum's invalidity contentions  
6 should be supplemented to the same level of detail that  
7 it's requesting GE's infringement contentions be  
8 supplemented.

9 THE COURT: Sure, that's fine.

10 Can you submit that by the 24th?

11 MS. BUTLER: Yes. So two pages for each party,  
12 just to make sure that we're all on the same page in letter  
13 format -- in a letter is fine?

14 THE COURT: A letter is fine. File it on ECF. If  
15 something needs to be under seal, just follow the  
16 procedures to that.

17 MS. BUTLER: Will do, your Honor.

18 MR. PEJIC: And, your Honor, Branko Pejic. One  
19 last thing that I know we're not going to get to today --

20 THE COURT: Right.

21 MR. PEJIC: -- but it's defendants' Motion 117,  
22 defendant still has not produced any technical discovery as  
23 the weeks pass. And, you know, that is hampering  
24 Spectrum's ability to make its case.

25 THE COURT: Right. I understand.

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2 MR. PEJIC: And we --

3 THE COURT: I read those contention  
4 interrogatories. Some of them are too broad. And we'll  
5 have to talk about it in another conference. We do have  
6 conferences scheduled out, but I'll look to see if I can  
7 get you in in early January -- because I think our next  
8 conference is late January -- so we can iron this out and  
9 you can get going. Okay?

10 MR. PEJIC: Understood. But this is actually  
11 defendants' Motion 117, not --

12 THE COURT: Right.

13 MR. PEJIC: -- plaintiff's motion.

14 THE COURT: I understand -- I understand. You want  
15 them to answer your contention interrogatories.

16 MR. PEJIC: No, we would -- no --

17 THE COURT: You want to serve the contention --

18 MR. PEJIC: Defendants have asked the Court for  
19 permission to serve contention interrogatories requiring --

20 THE COURT: Right.

21 MR. PEJIC: -- plaintiffs to identify all their  
22 trade secrets before any technical discovery is produced.  
23 This is despite the fact that we have identified trade  
24 secrets A through Q in the First Amended Complaint --

25 THE COURT: Right, right.

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2 MR. PEJIC: -- which has (indiscernible) two  
3 motions to dismiss.

4 THE COURT: Right. I understand.

5 MR. PEJIC: -- bit at the apple. And we're  
6 sitting here, you know, being denied proper discovery.

7 THE COURT: I understand.

8 MS. BUTLER: Your Honor, can I leave this for my  
9 colleague, Mr. Jenike-Godshalk to handle so that I can jump  
10 off this call and onto the next?

11 THE COURT: Actually, yes, but we're going to end  
12 the conference, and we're just going to table this issue  
13 until early January. And I'm going to get another  
14 conference on. Okay?

15 MR. PEJIC: Thank you, your Honor.

16 MS. BUTLER: Thank you, your Honor.

17 THE COURT: All right, so I'm going to table it.  
18 I'll look forward to your submissions. And we're  
19 adjourned. Thanks, everybody.

20 MS. BUTLER: Thank you.

21 MR. PEJIC: Thank you, your Honor.

22 (Whereupon, the matter is adjourned.)  
23  
24  
25

C E R T I F I C A T E

I, Carole Ludwig, certify that the foregoing transcript of proceedings in the case of Spectrum Dynamics Medical Limited v. General Electric, Docket #18-cv-11386-VSB-KHP, was prepared using digital transcription software and is a true and accurate record of the proceedings.

Signature\_\_\_\_\_

Carole Ludwig

Date: December 21, 2020